



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595

8933 7590 03/26/2002

DUANE MORRIS, LLP
ATTN: WILLIAM H. MURRAY
ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103-7396

EXAMINER

BASHORE, WILLIAM L

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

R

Office Action Summary

Application No.
09/215,804

Applicant(s)
GAVIN et al.

Examiner
William L. Bashore

Art Unit
2176



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 5, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 2176

DETAILED ACTION

1. This action is responsive to communications: original application filed **12/18/1998**.
2. Claims 1-24 are pending. Claims 1, 5, 9, 13, 17, 21 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996.

In regard to independent claim 1, Anderson teaches:

- annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble "*A method of redacting content from a document in electronic form, comprising the steps of*").

- an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 1 "*selecting a geometric area on the document for redaction*", and "*representing said geometric area as one or more annotation objects*"). Anderson does not specifically teach said Overlay Object annotation as a source for

Art Unit: 2176

redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

- identification of information representing content/location/nature of content, said information represented as objects (Anderson Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 *"identifying information in the document representing content and location and nature of content"*, and *"representing said identified information as one or more content objects"*).

- a final-form document with annotated and/or redacted are present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 *"identifying content....to produce a redacted document."*).

In regard to dependent claims 2, 3, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claims 2, 3).

In regard to dependent claim 4, Anderson teaches a final-form document with annotated and/or redacted are present in said document, content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

Art Unit: 2176

In regard to independent claim 5, Anderson teaches:

- annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble "*A method of designating portions of a document for redaction, comprising the steps of*").

- displaying a document (Anderson column 6 lines 3-10; compare with claim 5 "*displaying all or a portion of the document*").

- an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 5 "*designating a geographical region of the document for redaction*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

- identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52; compare with claim 5 "*saving the designations with the document*").

Art Unit: 2176

In regard to dependent claim 6, Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

In regard to dependent claim 7, Anderson does not specifically teach a frame. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches a user specifying the location and orientation of an annotation on a final-form document (Anderson column 6 lines 12-20; compare with claim 7), suggesting the manipulation and orientation (framing) of an object on a page, providing the advantage of visually orientating an object in relation to the rest of the document.

In regard to dependent claim 8, Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches include structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 8), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of batch (all at once) processing.

In regard to claims 9-12, claims 9-12 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

Art Unit: 2176

In regard to claims 13-16, claims 13-16 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-8, and are rejected along the same rationale.

In regard to claims 17-20, claims 17-20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

In regard to claims 21-24, claims 21-24 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-8, and are rejected along the same rationale.

Conclusion

5. Prior art made of record and not relied upon is considered pertinent to disclosure.

LaMarca et al.	U.S. Patent No. 6,279,013	issued	08/2001
Anderson et al.	U.S. Patent No. 6,209,095	issued	03/2001
Rackman	U.S. Patent No. 5,903,646	issued	05/1999

Gladney, H.M., Access control for large collections, ACM Transactions on Information Systems (TOIS), Volume 15, Issue 2, April 1997, pp. 154-194.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Art Unit: 2176

Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

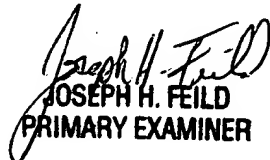
(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

William L. Bashore
3/15/2002


JOSEPH H. FEILD
PRIMARY EXAMINER